

INTERNATIONAL COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference MCA-449 PC	FOR FURTHER ACTION <small>see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.</small>	
International application No. PCT/US 99/ 28501	International filing date (day/month/year) 02/12/1999	(Earliest) Priority Date (day/month/year) 03/12/1998
Applicant MILLIPORE CORPORATION et al.		

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 3 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing :

☐ contained in the international application in written form.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ **Certain claims were found unsearchable** (See Box I).

3. ☐ **Unity of invention is lacking** (see Box II).

4. With regard to the **title**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,

☒ the text is approved as submitted by the applicant.

☐ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No.

☐ as suggested by the applicant.

☒ because the applicant failed to suggest a figure.

☐ because this figure better characterizes the invention.

1A

☐ None of the figures.

INTERNATIONAL SEARCH REPORT

International Application No

PO/US 99/28501

A. CLASSIFICATION OF SUBJECT MATTER

IPC 7 B01D27/02 B01D24/02 B01D39/16 B01D39/08

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 7 B01D

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	US 5 472 600 A (ELLEFSON PETER J ET AL) 5 December 1995 (1995-12-05) column 1, line 21 column 2, line 25-30 column 3, line 6-25 column 5, line 1-45; figures	1,4,6,9, 11,13
X	DE 35 16 341 A (HINTERBERGER JOHANN;STREUBEL UWE) 13 November 1986 (1986-11-13) page 7; figure 1	1,2,6,7, 18,19
X	US 1 934 251 A (HARVEY D. AUSTIN) 7 November 1933 (1933-11-07) the whole document	1,5,17
	--- -/-- ---	

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents :

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier document but published on or after the international filing date

"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

"&" document member of the same patent family

Date of the actual completion of the international search

8 May 2000

Date of mailing of the international search report

16/05/2000

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Polesak, H

INTERNATIONAL SEARCH REPORT

International Application No

US 99/28501

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	DE 17 86 334 A (ZIMMER, CORNELIUS, P.) 23 December 1971 (1971-12-23) the whole document ----	1,3,6,8, 10
X	US 4 839 048 A (REED CLAYTON L ET AL) 13 June 1989 (1989-06-13) column 4 -column 5; figure 6 ----	1,5,6, 10,17,19
A	WO 97 35125 A (ADVANCED STRUCTURES INC ;DARBY C PETER (US); EISBERG DOUGLAS (US);) 25 September 1997 (1997-09-25) ----	
A	US 5 595 651 A (PAVEL AUGUSTIN) 21 January 1997 (1997-01-21) -----	

INTERNATIONAL SEARCH REPORT

Information on patent family members

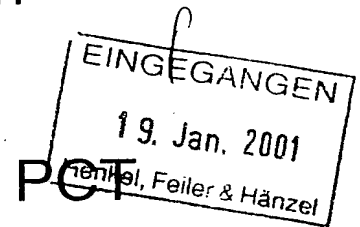
International Application No

US 99/28501

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
US 5472600 A	05-12-1995	AU 4524096 A BR 9510447 A DE 69512088 D EP 0806979 A JP 10513113 T WO 9623572 A	21-08-1996 19-05-1998 14-10-1999 19-11-1997 15-12-1998 08-08-1996
DE 3516341 A	13-11-1986	NONE	
US 1934251 A	07-11-1933	NONE	
DE 1786334 A	23-12-1971	NONE	
US 4839048 A	13-06-1989	NONE	
WO 9735125 A	25-09-1997	US 5720411 A AU 2207597 A CA 2248795 A CN 1214110 A EP 0886737 A	24-02-1998 10-10-1997 25-09-1997 14-04-1999 30-12-1998
US 5595651 A	21-01-1997	NONE	

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY



To:

HENKEL, FEILER & HÄNZEL
Möhlstrasse 37
81675 - MÜNCHEN
ALLEMAGNE

NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT (PCT Rule 71.1)

Date of mailing
(day/month/year) 18.01.2001

Applicant's or agent's file reference
MCA-449 PC

IMPORTANT NOTIFICATION

International application No.
PCT/US99/28501

International filing date (day/month/year)
02/12/1999

Priority date (day/month/year)
03/12/1998

Applicant
MILLIPORE CORPORATION et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

Name and mailing address of the IPEA/

 European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized officer

Ipinazar, P

Tel. +49 89 2399-8131



PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference MCA-449 PC	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US99/28501	International filing date (day/month/year) 02/12/1999	Priority date (day/month/year) 03/12/1998
International Patent Classification (IPC) or national classification and IPC B01D27/02		
Applicant MILLIPORE CORPORATION et al.		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 10 sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the report II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input checked="" type="checkbox"/> Certain defects in the international application VIII <input checked="" type="checkbox"/> Certain observations on the international application 		
Date of submission of the demand 03/07/2000	Date of completion of this report 18.01.2001	
Name and mailing address of the international preliminary examining authority: <div style="display: flex; align-items: center;"> <div> European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465 </div> </div>	Authorized officer Polesak, H Telephone No. +49 89 2399 8628	



**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US99/28501

I. Basis of the report

1. This report has been drawn on the basis of *(substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments (Rules 70.16 and 70.17).):*

Description, pages:

1-3,5,6,8-10,15, 17 as originally filed

4,7,11-14,16 as received on 05/12/2000 with letter of 05/12/2000

Claims, No.:

1-18 as received on 05/12/2000 with letter of 05/12/2000

Drawings, sheets:

1/11-11/11 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US99/28501

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims
	No: Claims 1,16
Inventive step (IS)	Yes: Claims
	No: Claims 1-18
Industrial applicability (IA)	Yes: Claims 1-18
	No: Claims

2. Citations and explanations
see separate sheet

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:
see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:
see separate sheet

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US99/28501

Regarding Point V

- (1) US-A-4 839 048
- (2) US-A-5 472 600
- (3) DE-A-35 16 341
- (4) US-A-1 934 251
- (5) DE-A-17 86 334

1. Document (1) describes a filter cartridge comprising a hollow housing having first and second ends, the respective ends include an inlet and an outlet. The housing is filled with a depth filter. The housing is free of an open void volume **upstream** of the depth filter, i.e. at the inlet side of the housing. The housing is also free of an open void volume **downstream** of the depth filter, i.e. at the outlet side of the housing, as the lugs between the cap and the filter unit are considered optional in document (1), see column 5, line 45 to 48 and the claims. Document (1), concerns the same filter cartridge and method, see column 6, line 24 to 29, as the present application, hence the present set of independent claims does not meet the requirements of novelty in the sense of Article 33(2) PCT. The claims also lack novelty over the disclosure of document (2): The housing is free of an open void volume at one side of the housing.
2. Dependent claims 2-15 and 17 and 18 define features which are either known from the prior art document (1) or involve special embodiments of the invention and thus represent nothing which could impart patentability to any one of the main claims. In particular document (1) describes the features of Claims 5, 16, 8 and 10, document (2) describes the features of Claims 4, 16 and 17; document (3) describes the features of Claims 2, 16, 7, 9 and 10; document (4) describes the features of Claims 5 and 8; document (5) describes the features of Claims 3 and 16.

Regarding Point VII

1. The description should be made consistent with the claims and should include a proper acknowledgement of the prior art (1); Rule 5.1(a)(ii) PCT.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US99/28501

Regarding Point VIII

1. The dependency of claim 8 is incorrect as claim 1 defines a void on the upstream side of said depth filter and not on the downstream side.
2. The relative term "upstream" and "downstream" in respective claims 1 and 8 does not unambiguously define the spatial position of the open void volume and should be replaced by the feature "the space in the housing between the first end and/or the second end of the housing and the depth filter is free of an open void volume".

REC'D 22 JAN 2001

WIPO

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT



(PCT Article 36 and Rule 70)

Applicant's or agent's file reference MCA-449 PC	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US99/28501	International filing date (day/month/year) 02/12/1999	Priority date (day/month/year) 03/12/1998
International Patent Classification (IPC) or national classification and IPC B01D27/02		
Applicant MILLIPORE CORPORATION et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
- ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
- These annexes consist of a total of 10 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☒ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 03/07/2000	Date of completion of this report 18.01.2001
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized officer Polesak, H Telephone No. +49 89 2399 8628 

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/US99/28501

I. Basis of the report

1. This report has been drawn on the basis of *(substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments (Rules 70.16 and 70.17).):*

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1-3,5,6,8-10,15, 17 as originally filed

4,7,11-14,16 as received on 05/12/2000 with letter of 05/12/2000

Claims, No.:

1-18 as received on 05/12/2000 with letter of 05/12/2000

Drawings, sheets:

1/11-11/11 as originally filed

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- ☐ furnished subsequently to this Authority in written form.
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- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US99/28501

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims
	No: Claims 1,16
Inventive step (IS)	Yes: Claims
	No: Claims 1-18
Industrial applicability (IA)	Yes: Claims 1-18
	No: Claims

2. Citations and explanations
see separate sheet

VII. Certain defects in the international application

The following defects in the form or contents of the international application have been noted:
see separate sheet

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:
see separate sheet

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US99/28501

Regarding Point V

- (1) US-A-4 839 048
- (2) US-A-5 472 600
- (3) DE-A-35 16 341
- (4) US-A-1 934 251
- (5) DE-A-17 86 334

1. Document (1) describes a filter cartridge comprising a hollow housing having first and second ends, the respective ends include an inlet and an outlet. The housing is filled with a depth filter. The housing is free of an open void volume **upstream** of the depth filter, i.e. at the inlet side of the housing. The housing is also free of an open void volume **downstream** of the depth filter, i.e. at the outlet side of the housing, as the lugs between the cap and the filter unit are considered optional in document (1), see column 5, line 45 to 48 and the claims. Document (1), concerns the same filter cartridge and method, see column 6, line 24 to 29, as the present application, hence the present set of independent claims does not meet the requirements of novelty in the sense of Article 33(2) PCT. The claims also lack novelty over the disclosure of document (2): The housing is free of an open void volume at one side of the housing.
2. Dependent claims 2-15 and 17 and 18 define features which are either known from the prior art document (1) or involve special embodiments of the invention and thus represent nothing which could impart patentability to any one of the main claims. In particular document (1) describes the features of Claims 5, 16, 8 and 10, document (2) describes the features of Claims 4, 16 and 17; document (3) describes the features of Claims 2, 16, 7, 9 and 10; document (4) describes the features of Claims 5 and 8; document (5) describes the features of Claims 3 and 16.

Regarding Point VII

1. The description should be made consistent with the claims and should include a proper acknowledgement of the prior art (1); Rule 5.1(a)(ii) PCT.

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US99/28501

Regarding Point VIII

1. The dependency of claim 8 is incorrect as claim 1 defines a void on the upstream side of said depth filter and not on the downstream side.
2. The relative term "upstream" and "downstream" in respective claims 1 and 8 does not unambiguously define the spatial position of the open void volume and should be replaced by the feature "the space in the housing between the first end and/or the second end of the housing and the depth filter is free of an open void volume".

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

RECEIVED

PCT

MAY 24 2000

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

LEGAL DEPT

(PCT Rule 44.1)

To:
MILLIPORE CORPORATION
Attn. HUBBARD, J.
80 Ashby Road
Bedford, Massachusetts 01730
UNITED STATES OF AMERICA

Date of mailing
(day/month/year) 16/05/2000

Applicant's or agent's file reference

MCA-449 PC

FOR FURTHER ACTION See paragraphs 1 and 4 below

International application No.

PCT/US 99/28501

International filing date
(day/month/year)

02/12/1999

Applicant

MILLIPORE CORPORATION et al.

1. ☒ The applicant is hereby notified that the International Search Report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the International Application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the International Search Report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland
Facsimile No.: (41-22) 740.14.35

Docketed By: **MCA-449 PC**
Due Date: **ART. 19 Amend**
Reminder(s): **due b/f July 19 2000**

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no International Search Report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:
- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after 18 months from the priority date, the International application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the International application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for International publication.

Within 19 months from the priority date, a demand for International preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within 20 months from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the International Searching Authority



European Patent Office, P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Véronique Baillou

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule", and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When?

Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How?

Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.